

Response

Applicant: Gary B. Gordon et al.

Serial No.: 09/812,252

Filed: March 19, 2001

Docket No.: 10010189-1

Title: IMPEDANCE SENSING SCREEN POINTING DEVICE

REMARKS

The following remarks are made in response to the Non-Final Office Action mailed January 12, 2006. In that Office Action, the Examiner rejected claims 1-35 under 35 U.S.C. §103(a) as being unpatentable over Gillespie et al., U.S. Patent No. 5,880,411 ("Gillespie").

With this Response, Applicant respectfully traverses the Examiner's rejection of claims 1-35. Claims 1-35 remain pending in the application and are presented for reconsideration and allowance.

35 U.S.C. §103 Rejections

The Examiner rejected claims 1-35 under 35 U.S.C. §103(a) as being unpatentable over Gillespie et al., U.S. Patent No. 5,880,411 ("Gillespie"). Independent claim 1 recites "the controller configured to generate movement data based on a comparison of successively generated sets of the pixel values, the comparison including comparing a first one of the sets with at least one pixel shifted version of a second one of the sets, the movement data indicative of motion of the tip of the digit across the sensing elements." With respect to independent claims 1 and 19, the Examiner stated that:

Gillespie does not specifically teach "a controller configured to generate movement data based on a comparison of successively generated sets of the pixel values, the comparison including comparing a first one of the sets with at least one pixel shifted version of a second one of the sets, the movement data indicative of motion of the tip of the digit across the sensing elements".

Gillespie on the other hand teaches gesture unit 20, which is used to recognize certain finger gestures performed by a user on a sensing plane 10. Gillespie teaches the gesture unit 20 in terms of determining whether a drag gesture is continuing or is being ended and a new finger action begun by comparing the lift-off finger position and the touchdown finger position (Fig. 1 (20), Fig. 14 (280, 286) and col. 36, lines 56-65).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize Gillespie's gesture unit (20) shown in Fig. 1 for the purpose of quantifying the movement of a finger on the sensing plane (10) as taught Gillespie (see Fig. 14 and Fig. 20). (Office Action at para. no. 2, page 3).

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The gesture unit 20 disclosed in Gillespie generates button-press signals that simulate a three-button (Left, Middle, Right) pointing device. (See, e.g., Gillespie at Fig. 14, and col. 33, lines 27-33). The disclosure regarding comparing a lift-off finger position with a touch-down finger position for the purpose of generating button-press signals does not teach or suggest generating movement data based on a comparison of successively generated sets of pixel values, the comparison including comparing a first one of the sets with at least one pixel shifted version of a second one of the sets, the movement data indicative of motion of the tip of the digit across the sensing elements, as recited in independent claim 1. There is no teaching or suggestion in Gillespie that the gesture unit 20 could or should be configured to generate movement data as recited in independent claim 1. Thus, Gillespie does not teach or suggest each and every limitation of independent claim 1.

In addition, even when obviousness is based on a single reference, there must be a showing of suggestion or motivation to modify the teachings of that reference. *In re Kotzab*, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). In the present case, the Examiner has not identified any suggestion or motivation to modify the Gillespie reference in a manner that would produce the claimed invention. Rather, the Examiner has essentially just indicated that it would be possible to modify Gillespie, without identifying any teaching, suggestion, or motivation, to make such a modification. Thus, by failing to identify a motivation to modify the Gillespie reference, the Examiner has failed to provide an essential element required to establish a *prima facie* case of obviousness.

Independent claim 19 recites “correlating at least one version of a first one of the digital images with at least one version of a second one of the digital images to generate motion data indicative of motion across the sensing elements by the appendage”. As described above, Gillespie does not teach or suggest “the controller configured to generate movement data based on a comparison of successively generated sets of the pixel values, the comparison including comparing a first one of the sets with at least one pixel shifted version of a second one of the sets, the movement data indicative of motion of the tip of the digit across the sensing elements”, as recited in independent claim 1. For at least the reasons described above with respect to

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independent claim 1, Gillespie also does not teach or suggest the above-quoted limitations of independent claim 19.

In view of the above, Gillespie does not teach or suggest each and every limitation of independent claim 1 or independent claim 19. Applicant respectfully requests removal of the rejection of claims 1 and 19 under 35 U.S.C. § 103(a), and requests allowance of these claims. Since dependent claims 2-18 and 20-35 further limit patentably distinct claim 1 or 19, and are further distinguishable over the cited reference, claims 2-18 and 20-35 are believed to be allowable over the cited reference. Allowance of claims 2-18 and 20-35 is respectfully requested.

CONCLUSION

In view of the above, Applicant respectfully submits that pending claims 1-35 are in form for allowance and are not taught or suggested by the cited references. Therefore, reconsideration and withdrawal of the rejections and allowance of claims 1-35 is respectfully requested.

No fees are required under 37 C.F.R. 1.16(h)(i). However, if such fees are required, the Patent Office is hereby authorized to charge Deposit Account No. 50-3718.

The Examiner is invited to contact the Applicant's representative at the below-listed telephone numbers to facilitate prosecution of this application.

Any inquiry regarding this Response should be directed to either William P. O'Meara at Telephone No. (303) 298-9888, Facsimile No. (303) 297-2266 or Jeff A. Holmen at Telephone No. (612) 573-0178, Facsimile No. (612) 573-2005. In addition, all correspondence should continue to be directed to the following address:

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CERTIFICATE UNDER 37 C.F.R. 1.8:

The undersigned hereby certifies that this paper or papers, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope address to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 9th day of March, 2006.

By: Jeff A. Holmen
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